REMARKS

In the Office Action dated August 22, 2002, the Examiner alleges that the present application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

I. Group I, claims 1-10 and 16-27, drawn to an isolated χ-conotoxin peptide, a composition comprising a χ-conotoxin peptide, a chimeric peptide comprising a segment of sequence of χ-conotoxin peptide and a segment of sequence of another biologically active peptide, a use of χ-conotoxin peptide in the manufacture of a medicament, and a method for the treatment or prophylaxis of urinary or cardiovascular diseases, or mood disorders or for the treatment of pain or inflammation, comprising administering to a mammal a χ-conotoxin peptide, classified in class 514, subclasses 14, class 530, subclass 327, and class 435, subclass 69.7.

II. Group II, claims 12, 13 and 15, drawn to an isolated nucleic acid comprising a sequence of nucelotides encoding or complementary to a sequence encoding a χ-conotoxin peptide, and a genetic construct comprising a vector and a nucleic acid capable of encoding a χ-conotoxin peptide, classified in class 536, subclass 23.5, and class 435, subclass 320.1.

III. Group III, claim 14, drawn to a monoclonal or polyclonal antibody specific to a χ-conotoxin peptide, classified in class 530, subclass 387.1.

IV. Group IV, claim 11, drawn to a use of χ-conotoxin peptide in a receptor binding assay to test the activity of a molecule as an inhibitor of neuronal noradrenaline transporter, classified in class 514, subclasses 14, class 530, subclass 327.

The Examiner contends that the claims in the different groups do not share the same or corresponding technical features. More specifically, the Examiner is of the opinion that each group is directed to distinct chemical entities and/or methods, which use different materials and produce different effects. Accordingly, the Examiner concludes that the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept. Therefore, the Examiner has required Applicants to elect a single invention to

which the claims must be restricted.

In order to be fully responsive to the Examiner's requirements for restriction, Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, claims 1-10 and 16-27, drawn to an isolated χ-conotoxin peptide, a composition comprising a χ-conotoxin peptide, a chimeric peptide comprising a segment of sequence of χ-conotoxin peptide and a segment of sequence of another biologically active peptide, a use of χ-conotoxin peptide in the manufacture of a medicament, and a method for the treatment or prophylaxis of urinary or cardiovascular diseases, or mood disorders or for the treatment of pain or inflammation, comprising administering to a mammal a χ-conotoxin peptide. However, pursuant to 37 C.F.R. §§1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

A requirement for restriction presupposes an analysis of the subject application in light of the rules governing this practice, i.e., 37 C.F.R. §1.499 and PCT Rules 13.1 and 13.2. PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')." (Emphasis added.) PCT Rule 13.2 states: "The expression "technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added.)

Applicants respectfully submit that Groups I-IV are not distinct as the Examiner has alleged, but rather represent one single inventive concept warranting examination in a single application. More specifically, the present invention provides an isolated χ-conotoxin peptide, compositions comprising the peptide and chimeric peptides (Group I), which are useful as

inhibitors of neuronal amine transporters if neurotransmitters. The isolated nucleic acid molecules of Groups II encode the χ-conotoxin peptide of Group I, and can be used to make the χ-conotoxin peptide of Group I for use in the methods of treatment of Group I. The antibodies of Group III are specific for the χ-conotoxin peptide of Group I, and therefore can be generated by using the χ-conotoxin peptide of Group I. On the other hand, the χ-conotoxin peptide of Group I can be purified by employing the antibodies of Group III. Group IV and its associated claims are directed to methods of testing the activity of a molecule as an inhibitor of neuronal noradrenaline transporter by using the χ-conotoxin peptide of Group I. Clearly, Groups I-IV are related to each other as different aspects of a single invention. It is submitted that each of the claimed inventions, when considered as a whole, defines a contribution over the prior art.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

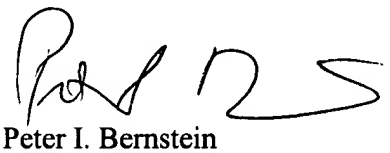
> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Accordingly, it is respectfully submitted that claims 1-27 satisfy the requirements for unity of invention. Applicants respectfully urge that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Finally, Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of all defined four groups, one from the other, as presented by the Examiner.

Respectfully submitted,



Peter I. Bernstein
Registration No. 43,497

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
PIB/XZ:ab